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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/140,752	08/25/1998	CHANDRAKANT BHAILALBHAI PATEL	A7256	9089

7590 07/23/2004

SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 20037

EXAMINER
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KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 07/23/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/140,752

Applicant(s)

PATEL ET AL.

Examiner

Victor R. Kostak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-121 is/are pending in the application.
- 4a) Of the above claim(s) 69-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Applicant's election without traverse of group I in the reply filed on 09/10/03 is acknowledged.

2. Applicant is reminded that the claims are numbered starting with claim 23 and ending with 121. (This is pointed out to inform applicant that some papers in the application still list the as claims starting with claim 2 and ending with claim 100). All referencing will be to the claims as if numbered from 23 to 121 (only elected claims 23-68, however, have actually been examined).

Applicant is also informed that his latest response lists claims 1-21 as being canceled, but claim 22 has also been canceled.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All of the independent claims recite the capability of satellite communication but the original disclosure does not recite or imply satellite communication. Applicants contend that "narrowcasting" implies satellite communication but narrowcasting can be done using standard

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terrestrial means (as well as through wired cable or fiber media). "Narrowcasting" only requires broadcasting to limited receiving ends but does not require satellite transmission.

Applicants are directed to MPEP 2163.07(a) that states *"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."*

Independent claims 23, 24, 53, 54 and 62-67, as well as dependent claims 25, 26, 38 and 43 all recite an *"adaptive decoder"*, *adaptive trellis decoder* or *"adaptively decoding"* but applicants do not have an adaptive decoder or disclose an adaptive decoding process.

Applicants have two separate decoders respectively dedicated to VSB and QAM formats. There is no adaptability of either decoder. Applicants select between their two decoders because they both perform specifically different decoding processes. Stewart, on the other hand, has an adaptive decoder 50 as part of overall decoder 12.

Applicants' *"differential decoder"* recited in claims 32 and 55, is not inherent and corroboration cannot be gotten from Stewart. Applicants refer to column 5 lines 23-30 in Stewart for support, but Stewart there states that differential encoding/decoding is a *"known technique"*, which is not the same as being necessarily or implicitly fully inclusive to QAM processing.

4. Regarding other matters, applicants' *"means for processing the data ..."* recited in claims 37 and 39, when considered under sixth paragraph of 35 USC 112, does not do the same

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processing as Stewart's. Applicants' means for processing involves VSB and QAM data whereas Stewart processes QPSK and QAM data.

Another salient point is that applicants' decoding is not a "*function of a code rate selected from a plurality of code rates*" like Stewart's is. Applicants' decoding (which is not adaptive) is selected based on pilot carrier presence or absence.

Another considerable difference, contrary to what applicants assert, is that applicants do not bypass an "adaptive decoder" whereas Stewart does (when QAM slicer is selected which causes the adaptive decoder 50 to be passed by). At any one time, either VSB decoder 38 or QAM decoder 37 must be in operation, and since applicants describe the composite arrangement of elements 38, 37 and 34 as being an "adaptive" decoder, it is never completely bypassed.

5. Claims 23-68 are allowable over the prior art.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is 703 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9306 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 308-HELP.



Victor R. Kostak  
Primary Examiner  
Art Unit 2614

VRK